

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 7, 2006. Claims 2-4, 6-13, 15-17, 19 and 20 are pending in this Application and Claims 1, 5, 14, and 18 have been cancelled without prejudice or disclaimer. Claims 2-4, and 6-13, 15-17, 19 and 20 were rejected under 35 U.S.C. § 103(a). Claims 11, 16 and 20 have been amended, and Applicants respectfully request reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. § 103**

Claims 2-12, 15, 16, 19, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,467,702 issued to Malcolm David Dick Lambert et al. ("Lambert") in view of U.S. Patent No. 6,055,957 issued to Toshiyuki Hasegawa et al. ("Hasegawa") and further in view of U.S. Patent No. 5,127,584 issued to David P. Sczomak ("Sczomak"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, do not render the claimed embodiment of the invention obvious.

Claims 3, 4, 13 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lambert in view of Hasegawa and Sczomak, and further in view of U.S. Patent No. 6,811,105 issued to Masaaki Kato et al. ("Kato"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, do not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Furthermore, according to § 2143 of the Manual of Patent Examining Procedure, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the

claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claims 11, 16, and 20 recite that "each injection orifice has a respective groove-shaped recess in the tip of the valve needle adapted to compensate for asymmetrical flow conditions." A premise of the rejection of these Claims is that "the recesses of the injection orifices of Lambert et al. ('702) are adapted to compensate for asymmetrical flow conditions." (Office Action, Page 3). However, nowhere in Lambert is it disclosed or suggested that the recesses 50, 52 are adapted for asymmetrical flow conditions. Furthermore, all figures of Lambert showing recesses 50, 52 depict such recesses as being *symmetrical* about the axis of valve needle 12. (See, e.g., Lambert, Figs 4-21). Thus, the premise of the rejection incorrectly asserts that Lambert discloses recesses adapted for asymmetrical flow conditions. Thus, the rejection fails to cite prior art that disclose all claimed limitations.

Claims 2-4, 6-10, 12 and 13 depend from claim 11, claims 15 and 17 depend from claim 16, and claim 19 depends from claim 20. These dependent claims are allowable as depending from an allowable base claim, and also as containing independently patentable features. Applicants respectfully request the withdrawal of the rejections of these dependent claims.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2690.

Respectfully submitted,  
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